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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,968	01/16/2002	Joseph M. Ross	HEND-AI	1544

7590 07/27/2004  
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EXAMINER

TO, TOAN C

ART UNIT PAPER NUMBER

3616

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/051,968

Applicant(s)

ROSS ET AL.

Examiner

Toan C To

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,3 and 11 is/are allowed.
- 6) ☒ Claim(s) 1 and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Japan Publication (JP. 11210794).

Japan Publication (JP. 11210794) discloses a suspension assembly of an axle/suspension system, the assembly having a beam, said beam including a bushing assembly for pivotally mounting the beam on a vehicle frame via a frame hanger, wherein the improvement comprises: means for substantially preventing (relative movement of at least one spacer disk (rubber ring 6) disposed between the bushing assembly (5) and the frame hanger (2), wherein the spacer disk generally being prevented from movement relative to the bushing assembly, whereby excessive wear to the spacer disk moving relative to the frame hanger (2) generally is prevented.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japan Publication (JP-11210794) in view of Figure 1 (Prior Art) of the present invention.

Japan Publication (JP-11210794) discloses every element of the invention as discussed above except that the spacer apparatus is formed in one piece of ultra-high molecular weight polyethylene.

Figure 1 (Prior Art) of the present invention teaches the spacer apparatus (28) is formed in one piece of ultra-high molecular weight polyethylene in order to prevent rattling noises from being caused by contact between the bushing and the vehicle bracket.

It would have been obvious design choice for one having ordinary skill in the art at the time the invention was made to modify bushing system of Japan Publication (JP-11210794) as taught by Figure 1 (Prior Art) of the present invention to include the spacer apparatus is formed in one piece of ultra-high molecular weight polyethylene in order to prevent rattling noises from being caused by contact between the bushing and the vehicle bracket.

### ***Response to Arguments***

5. Applicant's arguments filed April 15, 2004 have been fully considered but they are not persuasive. The prior art still reads on the claimed limitations.

In response to applicant's argument that "spacer disks are not even involved in the teachings of this reference (JP. 11210794)", applicant is noted that anticipation does not require that the prior art reference "teach" what the application at issue teaches, but only that the claim at issue "read on" what is disclosed in the prior art reference. In

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this case, '794 Japan discloses a rubber ring have being disposed between the bracket wall 2 and the tube 4 to form a space between the wall and tube 4, therefore, the rubber ring is considered to read on/correspond to "spacer disk" as claimed.

6. In response to applicant's argument that that '794 does not discloses "means for prevent relative movement of the spacer disk.....whereby excessive wear to the spaer disk moving relative to the frame hanger is generally is prevent", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, '794 discloses a rubber ring 6 being mounted between the frame hanger bracket 2 and bushing assembly 5 by bolt 13, wherein the bolt 13 is prevented movement of the rubber ring 6 relative to the frame hanger bracket 2 and bushing assembly 5, therefore the bolt 13 is considered to correspond to "means for prevent". Further, '794 discloses the surface of rubber ring 6 is constructed with a surface of lubricating member, so that the lubricant reduces the frictional resistance between the bracket 2 and rubber ring 6, in other words, if the friction resistance between the rubber ring 6 and the bracket 2 is reduced than the excessive wear to the rubber ring moving relative the bracket 2 is prevented.

***Allowable Subject Matter***

7. Claim 2-3 and 11 are allowed.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan C To whose telephone number is (703) 306-5951. The examiner can normally be reached on Mon-Fri (8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on (703) 308-2089. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

To, T 

July 22, 2004

  
RUTHILANA  
PATENT EXAMINER  
7/26/04